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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,660	08/16/2006	Yasuyuki Sanai	Q96171	9972

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
MCCLENDON, SANZA L	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/589,660	SANAI, YASUYUKI	
	Examiner	Art Unit	
	Sanza L. McClendon	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on April 06, 2009, the examiner has carefully considered the amendments. Please be advised that the record has changed. The new examiner is Sanza L. McClendon. Please find all correspondence information below.

2. The Declaration under 37 CFR 1.132 filed 10/22/2008 is insufficient to overcome the rejection of claims based upon Fukushima et al (5,969,867) as set forth in the last Office action because: While showing unexpected results over the a composition comprising MPSMA compound, the declaration is silent with regards the bis(4-(meth)acryloyloxydiethoxyphenyl) sulfide and/or other sulfide compounds that are represented by formula II and found in column 6, i.e., compounds that are closest in structure to applicant's claimed invention. The MPSMA while having a sulfide linkage between the phenyl rings also has sulfur moieties linking the (meth) acrylic groups to said phenyl groups. Therefore it is deemed the similarities between the claimed formula (1) and the MPSMA of the claims stops at the phenylene linkage.

Response to Arguments

3. Applicant's arguments filed Remarks/Amendment have been fully considered but they are not persuasive. Applicant appears to be relying on the declaration comparing MPSMA from the reference to the BAPS of the claims. Applicant argues that they only

need to compare the claimed invention to the closest specific example in the prior art (or a closer embodiment) and submit the Declaration does such. This is not persuasive since applicant did not compare the "closer" embodiment of the invention, which would be as suggest by Examiner Treidl, i.e., an example where BI, as taught by the reference is the bis(4-(meth)acryloyloxydiethoxyphenyl) sulfide and/or other sulfide compounds that are represented by formula II and found in column 6. Therefore the rejections still stand.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (US 5,969,867).

Regarding claims 7 and 9-15, Fukushima et al teach an active ray-curable composition (Abstract) comprising an active energy ray-sensitive radical polymerization initiator (5:4-5) {photoinitiator}, bis(4-(meth)acryloyloxyphenyl) sulfide (Structure II 5:55-6:15, wherein Z=S, p &q=0, n&m=0; reference component B-1), and 2-

phenylphenyl(meth)acrylate (8:2; reference component B-2) {o-phenylphenyl acrylate}. Selecting p&q=0, n&m=0 and R^2 to be hydrogen would be a natural starting point for one of ordinary skill in the art at the time of the invention attempting to reproduce the findings of the prior art by first formulating the simplest structure. Additionally, the selection of Z being sulfide, requires nothing more than choosing one of four equivalent options (6:10-15), and with the advent of combinatorial chemistry and microarray technology it would not have required undue experimentation to arrive at bis(4-(meth)acryloyloxyphenyl) sulfide.

Regarding claim 8, Fukusima et al teach the composition comprising 10-90 parts by weight of instant structure (1) (7:3-5, wherein instant structure (1) is equivalent to reference component (B-1)) and 1-50 parts by weight of instant structure (2) (8:15-17, wherein instant structure (2) is equivalent to reference component (B-2)). Furthermore, the reference teaches the composition specifically containing 19.6 wt % and 34.3 wt % of instant structure (1) and instant structure (2), respectively, per examiner's calculations (Table 2 Ex. 11, reference component (B-1) is equivalent to instant structure (1) & reference component (B-2) is equivalent to instant structure (2)).

Regarding claim 16, Fukushima et al teach the cured composition having a refractive index of 1.62 or higher (9:39), however the reference is silent to the temperature at which the refractive index is measured. Additionally, the reference teaches the refractive index of equivalent compositions being higher than 1.62 at 20°C (Table 2 Ex. 8, 9, 11, 12 & 13, 10:64). The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference

teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a refractive index of 1.61 or higher at 25 ºC, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 17, Fukushima et al teach the active energy ray-curable composition as a lens sheet (Abstract).

Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (US 5,969,867).

Regarding claims 18 and 20-26, Fukushima et al teach a method for producing a lens sheet comprising casting an active energy ray-curable composition into a lens mold and irradiating for curing (9:7-16). Furthermore, Fukushima et al teach the active ray-curable composition (Abstract) comprising an active energy ray-sensitive radical polymerization initiator (5:4-5) {photoinitiator}, bis(4-(meth)acryloyloxyphenyl) sulfide (Structure II 5:55-6:15, wherein Z=S, p &q=0, n&m=0; reference component B-1), and 2-phenylphenyl(meth)acrylate (8:2; reference component B-2) {o-phenylphenyl acrylate}. Selecting p&q=0, n&m=0 and R^2 to be hydrogen would be a natural starting point for one of ordinary skill in the art at the time of the invention attempting to reproduce the findings of the prior art by first formulating the simplest structure. Additionally, the

selection of Z being sulfide, requires nothing more than choosing one of four equivalent options (6:10-15), and with the advent of combinatorial chemistry and micro array technology it would not have required undue experimentation to arrive at bis(4-(meth)acryloyloxyphenyl) sulfide.

Regarding claim 19, Fukusima et al teach the composition comprising 10-90 parts by weight of instant structure (1) (7:3-5, wherein instant structure (1) is equivalent to reference component (B-1)) and 1-50 parts by weight of instant structure (2) (8:15-17, wherein instant structure (1) is equivalent to reference component (B-2)). Furthermore, the reference teaches the composition specifically containing 19.6 wt % and 34.3 wt % of instant structure (1) and instant structure (2), respectively, per examiner's calculations (Table 2 Ex. 11, reference component (B-1) is equivalent to instant structure (1) & reference component (B-2) is equivalent to instant structure (2)).

Correspondence

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/
Primary Examiner
Art Unit 1796